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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/773,752 | 02/02/2001 | Takashi Yamaguchi | 0649-0772P | 6901 |

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| EXAMINER | |
|---|---|
| YOON, TAE H | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1714 | |

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

| Office Action Summary | Application No. 09/773,752 | Applicant(s) Yamaguchi, et al. |
|---|---|---|
| | Examiner T. Yoon | Group Art Unit 1714 |

*—Th MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—*

**P riod for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

☒ Responsive to communication(s) filed on 4-9-03.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

☒ Claim(s) 1-12 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

**Application Papers**

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Pri rity under 35 U.S.C. § 119 (a)-(d)**

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

**Attachm nt(s)**

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Referenc (s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Pat nt Drawing Review, PTO-948

☐ Other _____

**Office Action Summary**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Rejection of claims 1-12 are under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,300,387 B2 is maintained **since the examiner does not find a terminal disclaimer contrary to applicant's statement**.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Rejection is mainained for reason of record and following.

Applicant asserts that said substantially free of ethylenicaly unsaturated group-containing monomers refers to added monomers such as styrene, and that a polyester resin means a composition comprising a polyester, styrene and the like. However, said argument is unpersuasive since the instant specification, especially examples, teaches "resin preparations" which do not contain said added monomers such as styrene. Thus, applicant's assertion that a polyester resin means a composition comprising a polyester, styrene and the like in the art has little probative value since applicant has used a term, "resin", which differs from the "ENCYCLOPEDIA OF CHEMICAL TECHNOLOGY" provided by applicant.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hefner, Jr. et al (US 4,524,178) in view of JP 63-305160.

Rejection is maintained for reason of record and following.

Applicant asserts that the intended use has probative value, and that there are differences between "fiber reinforce resin" of Hefner, Jr. et al and "resin reinforced fiber" of the invention. However, such argument has little probative value since it is like calling "a half-filled glass" and "a half-emptied glass" for the same glass. Note that the instant claims do not recite "yarn" or fabric" which supports applicant's statement, "resin reinforced fiber". The bottom page 3 of the specification teaches that the recited aggregate is not specifically limited and includes glass fiber or organic fiber which is preferred. In fact, the instant claim 2 recites a fibrous material which encompasses glass fiber and said fibers would yield "fiber reinforce resin" of Hefner, Jr. et al contrary to applicant's assertion.

Also, **the examiner does not find 37 CFR 1.132 declaration signed by Mr. Kawabe** and thus cannot address applicant's argument. The examiner would consider said declaration when (re)filed by applicant in next communication.

Again, the examiner interprets the recited substantially free of ethylenicaly unsaturated group-containing monomers encompasses up to 50 wt% of monomers absent any definition with respect to said "substantially free of".

With respect to applicant's argument regarding an intermediate of Hefner, Jr. et al, Hefner, Jr. et al teach "--- as intermediate materials which **can be mixed** with such monomers and cured at col. 7, lines 54-58. Thus, said "**can be mixed**" imples a possibility, not a mandatory use.

Besides, the claim 1 clearly claims "from **0** (to about 400) parts be weight of a non-resinous vinyl monomer per hundred parts of said alkyd" which meets the instant limitation.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al (US 5,077,326) or Wiseman (US 5,741,448) alone, or in view of JP 63-305160.

Rejection is maintained for reason of record and following.

Also, **the examiner does not find 37 CFR 1.132 declaration signed by Mr. Kawabe** and thus cannot address applicant's argument. The examiner would consider said declaration when (re)filed by applicant in next communication.

With respect to applicant's argument that Shibata et al does not indicate that BPA(AO) is preferrd, see ***In re Mills***, 477 F2d 649, 176 USPQ 196 (CCPA 1972); Reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples.

Again, the examiner interprets the recited substantially free of ethylenicaly unsaturated group-containing monomers encompasses up to 50 wt% of monomers absent any definition with respect to said "substantially free of".

Applicant failed to show that the unsaturated polyester resin in Polylite 31520 shown in example 1 of Wiseman and the unsaturated polyester resin shown at col. 4, lines 63-68 of Shibata et al do not have the instant softening point. The component (C ) of claim 11 is an optional component when combined with claim 9.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/May 9, 2003

Tae H. Yoon

TAE H. YOON
PRIMARY EXAMINER